

REMARKS

The applicants respectfully request reconsideration in view of the amendment and the following remarks. The specification has been amended as suggested by the Examiner. Claims 31, 32 and 33 were incorporated into independent claims 16, 26 and 28 respectively. In order to expedite prosecution, the applicants have cancelled the claims that recite DIN 53461. However, the applicants reserve the right to file a continuation on these claims at a later time.

Claims 18, 19/18, 21/18, 24/18, 25/18, 34/(16, 18), and 35/18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 16, 17, 18, 19/(17, 18), 21/(16, 17, 18), 24/(16, 17, 18), 25/(16, 17, 18), 28, 31, 33, 34/(16, 17, 18), and 35/(16, 17, 18) are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 16, 21/16, 26-30, and 35/16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masuda U.S. Patent No. 5,817,843 ("Masuda") combined with Inaba U.S. Patent No. 5,741,617 ("Inaba") and Minami U.S. Patent No. 5,179,171 ("Minami"), as evidenced by the *Aldrich Catalog*, page 1063, ("Aldrich") and *Polymer Technology Dictionary*, page 487 ("Polymer"). Claims 16, 21/16, 24/16, 26-33, and 35/16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshikawa U.S. Patent No. 5,292,609 ("Yoshikawa") combined with Minami, as evidenced by the *Aldrich* and *Polymer*. The applicants respectfully request traverse these rejections.

New matter in the specification

The Examiner objected to the amendment filed December 2, 2002. The Examiner stated that the amendment contained new matter. The applicants respectfully disagree. However, in order to expedite prosecution the applicants have deleted the phrase “is measured in decalin at 135°C” although the applicants believe that this phrase is inherent for the reasons stated in the amendment filed December 2, 2002.

The amendment describing the DIN specification is supported in the DIN as discussed in the amendment filed December 2, 2002.

35 U.S.C. 112, Second Paragraph Rejection

Claims 18, 19/18, 21/18, 24/18, 25/18, 34/(16, 18), and 35/18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In order to expedite prosecution the applicants have amended or cancelled these claims. For the above reasons, this rejection should be withdrawn.

35 U.S.C. 112, First Paragraph Rejection

Claims 16, 17, 18, 19/(17, 18), 21/(16, 17, 18), 24/(16, 17, 18), 25/(16, 17, 18), 28, 31, 33, 34/(16, 17, 18), and 35/ (16, 17, 18) are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The applicants believe that the claims as amended are in compliance with 35 U.S.C. 112, First Paragraph.

Again, as previously stated, the applicants believe that support for having one double bond can be found at page 4, four lines from the bottom of the page, “compound having **a** double bond, such as cyclohexene or norbornene.”. The term “a” indicates only one, therefore the phrase compound having a double bond means that there is only one double bond. For the above reasons, this rejection should be withdrawn.

Rejection of Masuda combined with Inaba and, as evidence by *Aldrich* and *Polymer*

Claims 16, 21/16, 26-30, and 35/16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masuda combined with Inaba and, as evidence by *Aldrich* and *Polymer*. The applicants believe that these claims are patentable, however, in order to expedite the applicants have incorporated the features of 31 into independent claims 16, 26 and 28. Since claim 31 was not rejected over these references, this rejection should be withdrawn.

Rejection of Yoshikawa combined with Minami, as evidence by the *Aldrich* and *Polymer*

Claims 16, 21/16, 24/16, 26-33, and 35/16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshikawa combined with Minami, as evidence by the *Aldrich* and *Polymer*.

The applicants do not agree with the arguments presented in item no. 10 of the Office Action. In the Yoshikawa patent, a developing agent is disclosed which is characterized by the presence of two polyolefin waxes with different softening point and by a vinyl-based polymer synthetic resin (col. 2, lines 1-7 and 42-45). Examples for vinyl-based polymer synthetic resin are given on col. 4, lines 15-20. In particular, Yoshikawa states at col. 4, lines 21-35:

Some of the examples used as a **binder** for the developing agent are styrene-based

copolymers such as

- (1) polystyrene,
- (2) styrene-butadiene copolymers and
- (3) styrene-acryl copolymer,
- ethylene-based copolymers** such as (4) **polyethylene,**
- (5) ethylene-vinyl acetate copolymer,**
- (6) ethylene-vinyl alcohol copolymer,**
- so-called petroleum resins such as (7) phenol-based resin,
- (8) polyamide resin,
- (9) polyester resin,
- (10) maleic-acid-based resin,
- (11) polymethyl methacrylate,
- (12) polyacrylic acid resin,
- (13) polyvinylbutyral,
- (14) aliphatic hydrocarbon resin,
- (15) **alicyclic hydrocarbon,** and
- (16) aromatic hydrocarbon,
- (17) chlorinated paraffin, and
- (18) mixtures thereof.

Especially, at least one styrene-based resin should be selected from the group consisting of polystyrene, styrene-butadien copolymer, and styrene-acryl-based copolymer.¹ (emphasis added)

None of the examples use an alicyclic hydrocarbon or ethylene based copolymers as can be used by the applicants' claimed invention. There would be no reason to selectively pick the alicyclic hydrocarbon or ethylene based copolymers in this group of 18 examples of binders to arrive at the applicants' claimed invention. While there are ethylene-based copolymers within this list there is absolutely no indication to use a copolymer as defined in the instant claims. The examples of ethylene-based copolymers given in Yoshikawa are totally different (col. 4, lines 25-26) from the binder used in the instant claims. Again, reference to "alicyclic hydrocarbon" on col. 4, line 30 can not overcome this deficiency. The applicants disagree with the Examiner's argument that a

person skilled in the art would have had a reasonable expectation of successfully obtaining an electrophotographic color toner having the properties disclosed by Yoshikawa when using the resin taught by Minami in the toner taught by Yoshikawa. In the applicants view such an interpretation can only be done when the instant invention is known.

The Examiner must consider the references as a whole, In re Yates, 211 USPQ 1149 (CCPA 1981). The Examiner cannot selectively pick and choose from the disclosed multitude of parameters **without any direction** as to the particular one selection of the reference **without proper motivation**. The mere fact that the prior art may be modified to reflect features of the claimed invention does not make modification, and hence claimed invention, obvious **unless the prior art suggested the desirability of such modification** is suggested by the prior art (In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984); In re Baird, 29 USPQ 2d 1550 (CAFC 1994) and In re Fritch, 23 USPQ 2d 1780 (Fed. Cir. 1992)). In re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (in a determination under 35 U.S.C. § 103 it is impermissible to simply engage in a hindsight reconstruction of the claimed invention; the references themselves must provide some teaching whereby the applicant's combination would have been obvious); In re Dow Chemical Co., 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988) (under 35 U.S.C. § 103, both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure). The applicants disagree with the Examiner why one skilled in the art with the knowledge of the references would selectively modify the references in order to arrive at the applicants' claimed invention. The Examiner's argument is clearly based on hindsight reconstruction.

¹ The numbers (1) –(18) were inserted by the applicants.
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Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching, suggestion, or incentive supporting this combination, although it may have been obvious to try various combinations of teachings of the prior art references to achieve the applicant's claimed invention, such evidence does not establish prima facie case of obviousness (In re Geiger, 2 USPQ 2d. 1276 (Fed. Cir. 1987)). There would be no reason for one skilled in the art to combine Yoshikawa combined with Minami, as evidence by the *Aldrich* and *Polymer*. For the above reasons, this rejection should be withdrawn.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 03-2775, under Order No. 05587-00342-USA from which the undersigned is authorized to draw.

Respectfully submitted,

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